

REMARKS

This is in response to the non-final Official Action currently outstanding with regard to the present application.

Claims 1-23 were pending in this application at the time of the issuance of the currently outstanding Official Action. By the foregoing Amendment, Claims 11, 14, 18 and 19 have been amended. Further, Claims 24 and 25 have been added. No claims have been either canceled or withdrawn. Accordingly, upon the entry of the foregoing amendment, Claims 1-25 will constitute the Claims under active prosecution in this application.

More particularly, in the currently outstanding Official Action the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and confirmed the receipt of the required copies of the priority documents by the United States Patent and Trademark Office;
2. Accepted the drawings as filed with this application on 4 December 2003;
3. Acknowledged his consideration of the Information Disclosure Statement filed in this application on 4 December 2003 by providing the Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed to confirm the consideration of the art listed therein;
4. Rejected Claims 18-23 under 35 USC §112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps;
5. Rejected Claim 19 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

6. Indicated that Claims 11 and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim(s) cannot depend from any other multiple dependent claim;
7. Rejected Claims 1 and 18 under 35 USC §102(b) as being anticipated by Matsumura (US Patent No. 5,862,447);
8. Rejected Claims 19-23 under 35 USC §102(b) as being unpatentable over Matsumura (US Patent No. 5,862,447) in view of Toyama et al. (US Patent No. 6,175,716);
9. Indicated that Claims 2-10, 12-13 and 15-17 are objected to as being dependent upon a rejected base claim, but that those claims would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims.

No further comment regarding items 1-3 above is deemed to be required in these Remarks.

With respect to item 4 above, the Examiner has rejected Claims 18-23 under 35 USC §112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Further, with respect to item 5 above, the Examiner has rejected Claim 19 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is Applicant's understanding that in these regards the Examiner is concerned that Claim 18 as originally filed does not adequately set forth the method steps associated with a paper transport apparatus for transporting one or more sheets of paper. It also is Applicant's understanding that the Examiner does not understand from the wording of Claim 19 as originally filed how the claimed voltage is being applied.

In response to the Examiner's concerns Applicant now has amended Claim 18 so as to include a "providing step" relating to the fact that a paper transport apparatus for transporting one or more sheets of paper is provided as part of the presently claimed method. Similarly, Applicant now has amended Claim 19 in a manner that is believed to clarify within the wording of the claim itself how the voltage(s) is/are applied to the carrier or carriers, the pressure roll or rollers and the leading edge portion or portions of the sheet or sheets of paper being transported. Applicant respectfully submits that the foregoing amendments to claims 18 and 19 overcome the Examiner's currently outstanding stated bases for the rejection of Claims 18-23 under 35 USC 112. A decision so holding in response to this communication is respectfully requested.

With regard to item 6, the Examiner has objected to Claims 11 and 14 under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim(s) cannot depend from any other multiple dependent claim. In response to this rejection, Applicant by the foregoing Amendment has amended Claims 11 and 14 so as to depend only from Claim 8, and has added Claims 24 and 25 that correspond to Claims 11 and 14 but depend from Claim 9. Applicant respectfully submits that this amendment removes the basis for the Examiner's objection under 37 CFR 1.75(c). A decision so holding in response to this communication is respectfully requested.

With regard to item 7, the Examiner has rejected Claims 1 and 18 under 35 USC §102(b) as being anticipated by Matsumura (US Patent No. 5,862,447). Further, in item 8, the Examiner has rejected Claims 19-23 under 35 USC §102(b) as being unpatentable over Matsumura (US Patent No. 5,862,447) in view of Toyama et al. (US Patent No. 6,175,716).

Applicant's detailed review of the Examiner's substantive rejections of the claims of this application has lead Applicant to believe that the Examiner has either misunderstood or mischaracterized the Matsumura reference. Specifically, Applicant respectfully submits that when the Matsumura reference is correctly understood, the bases of the Examiner's substantive rejections under 35 USC 102(b) and 35 USC 103(a) are not supported by the disclosure of the references upon which he relies and should be withdrawn. In this regard, Applicant respectfully submits that while an argument might be made in support of the position that the Matsumura reference discloses most of the elements of Claims 1 and 18 of this application, the fact nevertheless remains that the Matsumura reference totally fails to teach, disclose or suggest "at least one of the sheet or sheets of paper being transported from at least one of the paper transport means toward at least one of the transfer means" (emphasis added) as herein claimed..

More particularly, Applicant respectfully submits that a detailed review of the Matsumura reference reveals that nowhere in that reference is it specified (or suggested) that paper sheets are directed into the nip between the image carrier 13 at Q₃ and the transfer roller 57 such that the forward edges thereof are directed *toward the transfer roller 57 as opposed to being directed either directly into the nip or toward the image carrier 13*. Accordingly, while Applicants generally agree with the Examiner's assertions (1) that the Matsumura reference discloses paper transport roller pairs located on the image carrier side of a plane more or less tangent to the nip between the image carrier 13 and the transfer roller 57 (see roller pairs 63 and 43/44, **not 64 as alleged by the Examiner**), and (2) that those roller pairs might be broadly construed as being in the transport path of the paper, Applicant cannot agree that the Matsumura reference in any way discloses, teaches or suggests that paper sheets fed to the image transfer location between the image carrier 13 and the transfer roller 57 by the roller pair 28 located immediately below the transfer location in Matsumura's Fig. 2 are in any way direct toward the transfer means (i.e., in the context of Claim 1 of this application, the transfer roller 57).

Applicant respectfully submits that this position is clearly supported when an approximation of the plane more or less tangent to the nip between the pressure rollers of the roller pair 28 immediately below the image transfer location in Matsumura's Fig. 2 is considered. Further, Applicant respectfully submits that the construction of the Matsumura reference as it relates to the present invention as herein claimed also is clear when an approximation of the directions at which paper is fed to the roller pair 28 just mentioned from the paper pathways shown at 66 extending upwardly from the various paper trays (i.e., a direction toward the image carrier as in the prior art discussed in the background section of this application) is considered.

Hence, Applicant respectfully submits that the Examiner has failed to show either anticipation or obviousness in the currently outstanding Official Action. This is because in order to establish "anticipation", the Examiner must show that each and every element of the claimed invention is found in a single prior art reference arranged and cooperating with each other in the manner claimed. For the reasons just discussed, Applicant respectfully submits that the Examiner has failed to provide such a showing in the currently outstanding Official Action in this case.

Also, in order to establish a *prima facie* case of unpatentability under 35 USC 103, the Examiner must satisfy the following criteria.

To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.* *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*, Emphasis added)

Applicant respectfully submits that the Examiner has not shown (and cannot show) that all of the limitations of the present claims are present in the prior art taken as a whole. Further, there is simply no support in the currently cited and applied references of any teaching, disclosure or suggestion within the “four corners” of that art that in any way would lead one skilled in the art (absent reference to the present disclosure) to make the combination of elements herein claimed.

Accordingly, Applicants respectfully submit that the foregoing Amendment has overcome all of the Examiner's formal objections/rejections of the present application. Further, Applicants respectfully submit that the Examiner has not established either a substantively supported case for the anticipation of the present invention or for the obviousness of the present invention over any combination of the cited prior art. In view of these conclusions, Applicants respectfully submit that all of the claims present in this application, i.e., Claims 1-25, now are in condition for allowance. Reconsideration of this application and its allowance in response to this communication, therefore, are respectfully requested.

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Applicant also believes that additional fees beyond those submitted herewith are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. 04-1105, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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SIGNATURE OF PRACTITIONER

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